

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Russell HIGUCHI

Application No.: 08/968,208

Group Art Unit: 1743

CPA Filed: November 20, 2000

Examiner: Snay, J.

For: INSTRUMENT FOR  
MONITORING NUCLEIC ACID  
AMPLIFICATION

RECEIVED

FEB 26 2003

TC 1700

Commissioner for Patents  
Washington, DC 20231

**Sir:**

**INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(b)**

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b), Applicant brings to the attention of the Examiner the documents listed on the attached Form PTO 1449. This Information Disclosure Statement is being filed along with a Request for Continued Examination (RCE).

Copies of the listed documents are enclosed.

French Publication No. 2,250,991 and WO 93 16194 are not in English. “Where the information is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance [under 37 C.F.R. § 1.98(a)(3)] can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office.” (See MPEP §609 A(3), second

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paragraph.) Accordingly, applicant encloses a copy of the European Search Report from a counterpart European Patent Application No. 02015199, in which both French Publication No. 2,250,991 and WO 93 16194 were cited. Applicant also encloses an English translation of French Publication No. 2,250,991 prepared by Okada & Sellin Translations, LLC.

Applicant encloses copies of European Search Reports from related European Patent Application Nos. EP 92106989 and EP 02015199. Applicant also encloses copies of European Search Reports published with European Patent Application Nos. EP 98110423 and EP 94112728.

Applicant also encloses copies of papers up to April 18, 2001, from the file history of related U.S. Application Serial No. 08/266,061 (the '061 application). The '061 application was filed as a continuation-in-part of U.S. Application Serial No. 08/113,168, which was filed as a continuation-in-part of U.S. Application Serial No. 07/695,201 (the '201 application). The '201 application is a parent application of the present application Serial No. 08/968,208. In an abundance of caution, the following discussion addresses certain statements made during prosecution of the '061 application.

In the '061 application, the Examiner stated that

the scope of the disclosure of [the '201 application] is detailed in the instant specification at pages 11-12 as enabling fluorescence detection of a single PCR reaction well. As such, the claims of this CIP application are afforded the 08/27/93 filing date of the later filed parent application, SN 113168, only.

See Office Action mailed July 8, 1996, in the '061 application, at page 4, item no. 3.

The Examiner stated that the file for the '201 application was not available, and thus,

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the Examiner's position appeared to be based solely on the '061 application specification. *See id.*

In a later response in the '061 application, the attorney for the applicant stated that "Applicant's first filed parent application, Application No. 07/695,201, filed May 2, 1991, related to a thermocycler using single reaction well monitoring." See Submission Under 37 C.F.R. § 1.129(a), filed August 11, 1997, in the '061 application, at page 6 (footnote 1). The applicant's attorney also noted the July 8, 1996, Office Action's conclusion that the '061 application was afforded the filing date of U.S. Serial No. 113, 168 only. *See id.* at the sentence bridging pages 6 and 7.

To avoid any possible confusion in the records at the US Patent and Trademark Office (USPTO), the following statements are provided.

The specification of the present application, which has the same disclosure as the '201 application, clearly supports and enables instruments for use in monitoring nucleic acid amplification reactions comprising a detector operable to detect a fluorescence optical signal from a plurality of vessels. The Examiner in the present application appears to agree, because claims 31 and 40 of the present application are directed to embodiments involving a plurality of reaction vessels. This issue is raised here, however, to make this point clear for the record.

In the interest of consistency, similar clarification will be submitted in due course in copending U.S. Application Serial No. 10/206,846, which is a

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continuation application of U.S. Application Serial No. 09/955,847 (abandoned), which is a continuation application of the '061 application (abandoned).

Applicant also encloses copies of certain papers from Interference No. 103,439, in which the '201 application was involved. The titles of those papers are included on the Form PTO 1449.

Copies of the following documents from Interference No. 103,439 are not enclosed: Higuchi Opposition to Mitoma's Motion for Compensatory Sanctions and Higuchi Opposition to Mitoma's Motion to Strike Sninsky Declaration-II. If the Examiner desires copies of those documents, applicant requests the Examiner to notify the undersigned so that he can attempt to obtain copies of such documents.

Applicant respectfully requests that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached form.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that any of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claim in the application and Applicant determines that the cited documents do not constitute "prior art" under United States law, Applicant reserves the right to present to the office the relevant facts and law regarding the appropriate status of such documents.

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Applicant further reserves the right to take appropriate action to establish the patentability of the claimed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: February 20, 2003

By:   
M. Paul Barker  
Reg. No. 32,013

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INTERFERENCE NO. 103,489

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. HIGUCHI MOTION FOR TESTIMONY AND DOCUMENTS FROM MITOMA
2. HIGUCHI REPLY I - INEQUITABLE CONDUCT BY MITOMA

were served upon Counsel as follows:

Steven B. Kelber  
Oblon, Spivak, McClelland  
Maier and Neustadt  
Fourth Floor  
1755 Jefferson Davis Highway  
Arlington, Virginia 22202

via First Class Mail, postage prepaid, this 15th day of May, 1995.

  
\_\_\_\_\_  
William H. Epstein

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper along with the above Higuchi Reply I and Motion as well as any paper referred to as being transmitted therewith is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

\_\_\_\_\_  
William H. Epstein  
(Print Name)

Date: May 15, 1995

  
\_\_\_\_\_  
(Signature)

96118

INTERFERENCE NO.: 103,489  
ATTORNEY DOCKET NO.: 73-369-0 FWC

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. MITOMA REPLY TO THE OPPOSITION TO MITOMA'S  
MOTION FOR COMPENSATORY SANCTIONS
2. MITOMA REPLY TO THE OPPOSITION TO MITOMA'S  
MOTION TO STRIKE SNINSKY DECLARATION-II
3. CERTIFICATE OF SERVICE

- were served upon Counsel as follows:

William H. Epstein  
Hoffmann-La Roche, Inc.  
340 Kingsland Street  
Nutley, NJ 07110

via First Class Mail, postage prepaid, this 7th day of July, 1995.

  
STEVEN B. KELBER

ATTORNEY DOCKET NO.: 73-369-0 FWC

INTERFERENCE NO.: 103,489  
ATTORNEY DOCKET NO.: 73-369-0 FWC

CERTIFICATE OF SERVICE

I hereby certify that true copies of:

1. MITOMA OPPOSITION TO THE HIGUCHI MOTION FOR TESTIMONY AND DOCUMENTS
2. MITOMA MOTION TO STRIKE HIGUCHI'S SNINSKY DECLARATION-II AND THE REPLY RELYING THEREON
3. MITOMA'S CERTIFICATION - 37 CFR §1.637(b)
4. MITOMA'S REPLY TO THE HIGUCHI OPPOSITION TO MITOMA'S CONTINGENT MOTION FOR BENEFIT
5. MITOMA'S MOTION FOR IMPOSITION OF COMPENSATORY SANCTIONS, 37 CFR §1.616(b) AND 635
6. CERTIFICATION UNDER RULE 637(b)
7. CERTIFICATE OF SERVICE

were served upon Counsel as follows:

William H. Epstein  
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via First Class Mail, postage prepaid, this 30TH day of MAY, 1995.

  
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